

THIS DISPOSITION IS NOT CITABLE AS
PRECEDENT OF THE TTAB

JUNE 18, 1997

Paper No. 11
EWH/kk

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Image Laboratories, Inc. dba Modern Research
Laboratories**

Serial No. 74/**603,930**

Kenneth J. Hovet for **Image Laboratories, Inc. dba Modern
Research Laboratories**

Cheryl Butler, Trademark Examining Attorney, Law Office 107
(**Janice O'Lear**, Acting Managing Attorney)

Before **Sams**, Hanak and Quinn, Administrative Trademark
Judges.

Opinion by **Hanak**, Administrative Trademark Judge:

**Image Laboratories, Inc. (applicant) seeks registration
of EUCALYPTUS CLENZ in typed capital letters** for "hair care
products, namely, medicated dandruff shampoo." The intent-
to -use application was filed on November 28, 1994.

The examining attorney refused registration pursuant to
section 2(e)(1) of the Lanham Trademark Act on the basis

that applicant's mark is merely descriptive of applicant's goods.

When the refusal was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant's prior attorney requested an oral hearing. On January 30, 1997 applicant appointed a new attorney who on April 7, 1997 withdrew applicant's request for an oral hearing.

In deciding whether a term is descriptive, it is important to keep in mind two legal principles which are pertinent to this case. First, the descriptiveness of a term is not determined in the abstract, but rather it is determined in relationship to the goods or services for which it is used. See In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) ("Appellant's proposed abstract test is deficient ... in failing to require consideration of its mark 'when applied to the goods' as required by the [trademark] statute."). Thus, applicant's argument that a consumer viewing a product and "only observing that it bears a label with a EUCALYPTUS CLENZ mark, likely would not be able to discern what [the product] is based solely on the mark," is misplaced. (Applicant's brief page 3). The proper inquiry is whether a prospective purchaser of medicated dandruff shampoo would, upon seeing the term EUCALYPTUS CLENZ on that particular product, be informed as to an ingredient, quality or

characteristic of the product. Abcor Development, 200 USPQ at 218.

Second, it must be remembered that in order for a term to be held descriptive as applied to particular goods and services, it need not describe all of the qualities, characteristics or ingredients of the goods or services. A term is descriptive if it describes but "one of the qualities or properties of the goods." In re Gyulay, 820 F.2d 216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987). At page 5 of its brief, applicant lists a number of "functions, purposes or uses" of its product which its purported mark EUCALYPTUS CLENZ "does not identify." Applicant states that "nowhere in the mark is [there] any mention of scalp buildup ... [and] nowhere in the mark is [there] any mention of itching and flaking." (Applicant's brief page 5).

Applicant's contentions are correct. However, applicant has conceded that its product contains eucalyptus and that its product cleanses hair. Indeed, applicant stated that it "does not intend to claim exclusive rights to the ingredient descriptive [sic], 'eucalyptus.'" (Applicant's brief page 3). Moreover, applicant has also conceded that it "does not claim exclusive rights to the term 'clenz.'" (Applicant's brief page 3.) Applicant has also stated that its proposed "compound mark contains words that define an ingredient or purpose of a related good." (Applicant's brief page 6). Hence, we find that the proposed mark EUCALYPTUS CLENZ is descriptive of medicated

dandruff shampoo in that it informs prospective purchasers not only of an ingredient of the product, but also of a function of the product (i.e. to cleanse hair). Moreover, the fact that applicant has misspelled the word "cleanse" (i.e. "clenz") does not change the descriptive character of the mark. Indeed, as previously noted, applicant has stated that it "does not claim exclusive right to the term 'clenz.'" (Applicant's brief page 3).

Finally, applicant has argued that "the present mark [EUCALYPTUS CLENZ], in its entirety, is not merely descriptive." (Applicant's brief page 6, original emphasis). While it is occasionally possible to combine two or more descriptive terms to form "an incongruous expression" that in its entirety is not descriptive of the relevant goods and services, such is not the case here. Gyulay, 3 USPQ2d at 1010. Applicant has offered no explanation as to why the combination of EUCALYPTUS with CLENZ results in such an incongruous combination. Quite to the contrary, applicant has stated that "a consumer viewing a product having a label with the present mark [EUCALYPTUS CLENZ] may form an impression that it is a cleaning solution which contains or provides the effects of eucalyptus extract." (Applicant's brief page 4).

Ser No. 74/603930

Decision: The refusal to register is affirmed.

J. D. Sams

E. W. Hanak

T. J. Quinn
Administrative Trademark
Judges, Trademark Trial
and Appeal Board